

REMARKS/ARGUMENTS

Status of Claims

Claims 1-20 are currently pending in the application. Claims 1, 8 and 15 have been amended. No claims have been canceled or added. Therefore, claims 1-20 are present for examination. No new matter is added by these amendments. Applicant respectfully requests reconsideration of this application as amended. Claims 1, 8, and 15 are independent claims.

Claims 1, 8 and 15 have been amended to more clearly elucidate the invention. In particular, the claims include the addition of an “intermediate system.” The intermediate system, in embodiments, executes the methods claimed herein. Further, the steps of the methods are more clearly defined. For example, claim 8 and claim 15 add steps for “determining if the first message response is consistent with the other account information received from the payor in the first message;” “if the first message response is inconsistent with the other account information, sending an error to the payor through the web interface;” “determining, from the first message response, if a payor account can validly fund the stored benefit account;” if the payor account cannot validly fund the stored benefit account, instruction for sending an error to the payor through the web interface;” and “if the first message response is consistent with the other account information and if the payor account can validly fund the stored benefit account, sending a second message to the application interface to fund the stored benefit account.”

35 U.S.C. §102 Rejection, Neofytides et al.

Claims 1-20 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Publ. No. 2002/0152168 to Neofytides et al. (“**Neofytides**”). Again, Applicants respectfully traverse the rejection because the Examiner has failed to set forth a *prima facie* case of anticipation. Indeed, for a patent publication to anticipate the claims, the publication must contain each and every element of the claims. See Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); see also MPEP § 2131.

In embodiments, the present invention provides a method for creating an open network stored benefit account. A purchaser can create the open network stored benefit account.

An example of an open network stored benefit account is a gift card from a particular branded credit card association, such as VISA™. In embodiments, a first message is received at a first interface and includes a purchaser account identifier. The purchaser account identifier is used to fund a stored benefit account. A first message response is returned that can be used to determine if a first message response is consistent with the other account information. A second message is received with the application interface and the second message includes recipient account information. The stored benefit account is created with the recipient account information and is backed by an account issuer.

Inherency:

The Examiner has stated that Neofytides describes the elements of the claims “inherently.” For example, the Examiner states: “Neofytides discusses the usage of a stored benefit account and as such discloses the creation of a stored value benefit fund account. *It is inherent to*, by means of usage of a stored value account in Neofytides to have an account which is already created.” *Office Action*, p. 9. In a further example, the Examiner states: “Neofytides *indirectly checks to verify sufficiency within the account*, and where none can be placed, adds funds to the account.” *Office Action*, p. 11. Finally, Examiner notes “that without a stored value account previously created, there could be no transaction by the account, whether it be in or out of the account.” *Office Action*, p. 12. Indeed, the Examiner’s argument appears to be summed up in the idea that if Neofytides includes a description of the use of a stored value account then Neofytides inherently discloses the creation of a stored value account using the method claimed in the present application. This assertion is *non sequitur* and the Applicants will explain.

Applicants first wish to draw the Examiner’s attention to MPEP § 2112 where it states:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive

matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Further, MPEP § 2112 states that “‘In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.’ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) . . .”

If Neofytides were to inherently describe the elements of the claims, it must be apparent that the stored value account used in Neofytides must have been created by the methods claimed in the present invention. This is not apparent because the stored value account in Neofytides may have been created using another method. For example, the stored value account may have been created by buying a stored value card at a retailer. The purchaser could have purchased the card at a point-of-purchase display and had the retailer put value in the account associated with the card. This example is only one of many different ways the stored value account in Neofytides could have been created. As such, Neofytides cannot inherently anticipate the claims just because Neofytides describes using a stored value account.

Missing Limitations:

In contrast to the claims, Neofytides does not create a stored benefit account but provides methods for transferring value using a stored benefit account. See Neofytides, ¶ [0021] (“The present invention *facilitates online money transfers in or out of a user’s stored value fund.*” (*Emphasis added.*)). Neofytides does not create the stored value fund nor does Neofytides describe any method for creating the stored value fund. See Neofytides, ¶ [0071] (“The depicted portion of the process begins in step 804 where the payee 130, payor 110 and amount are determined for the money transfer. In step 812, it is determined *if the stored value fund of the payor 110 has enough money to fund the transfer to the payee 130.*” (*Emphasis added.*)). That is, Neofytides assumes the stored value fund already exists.

Missing Limitation: “receiving a first message including a purchaser account identifier at an intermediate system, wherein the purchaser account identifier and other account information is entered by a purchaser with a web interface to create the stored benefit account”

Independent claim 1 requires that a first message be received with a purchaser account identifier. Neofytides does not show a message being received from a purchaser with a purchaser account identifier *to create stored value fund*. Rather, Neofytides shows a transfer from a stored value fund. See Neofytides, ¶ [0021] (“A period expiring and/or a threshold amount being met can cause the *transfer of money in or out of the stored value fund*.” (*Emphasis added*)). Therefore, Neofytides does not teach receiving a first message including a purchaser account identifier to create a stored value account, and Neofytides cannot anticipate the present claims.

Missing Limitation: “the intermediate system determines from the first message response if a purchaser account associated with the purchaser account identifier can validly fund the stored benefit account”

Independent claim 1 requires that the intermediate system determine whether the purchaser account can fund the stored value benefit account. Neofytides does not include an intermediate system and does not show a step of determining if the purchaser account or the payor account can fund the stored value benefit account. Rather, Neofytides simply adds money into the stored value account. See Neofytides, ¶ [0072] (“Where there is not sufficient funds in the stored value fund, processing *continues to step 816 to load funds*.” (*Emphasis added*)). This process is different than determining if a purchaser or payor account can even load funds into the stored value account and does not require or include an intermediate system. Therefore, Neofytides does not teach the intermediate system determining whether the purchaser account can fund the stored value benefit account, and Neofytides cannot anticipate the present claims.

Missing Limitation: “the intermediate system receiving the second message response, the second message response includes recipient account information, the stored benefit account is created with the recipient account information”

Independent claim 1 requires that the intermediate system receive a second message that includes recipient account information and that the stored value account is created from the account information. Neofytides does not show such a step of receiving a second message with account information and creating the stored value account with the account information. Rather, Neofytides describes credit card authorization messages that transfer money in or out of an existing account, not an account that is being created. See Neofytides, ¶ [0078]. These transaction messages in Neofytides are not the same. Therefore, Neofytides does not teach the intermediate system receiving a second message that includes recipient account information and also includes that the stored value account is created from the account information, and Neofytides cannot anticipate the present claims.

Claims 2-7 depend from allowable claim 1. Due to at least this dependency, claims 2-7 are also allowable over Neofytides. Claims 8 and 15 include similar claim elements as those recited in claim 1. As such, claims 8 and 15 are also allowable over Neofytides for similar reasons. Claims 9-14 depend from allowable claim 8; claims 16-20 depend from allowable claim 15. As such, due to at least this dependency, claims 9-14 and 16-20 are also allowable over Neofytides. Therefore, all claims are allowable over Neofytides and Applicants respectfully request Examiner to issue a notice of allowance at the earliest convenience.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

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Amdt. dated February 12, 2008
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Examining Group 3609

PATENT

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Tadd F. Wilson', with a long horizontal flourish extending to the right.

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